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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,371	04/25/2001	Diane C. Breidenbach		6561

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Thomas A. O'Rourke  
BODNER & O'ROURKE  
425 Broadhollow Road  
Melville, NY 11747

EXAMINER

NGUYEN, TUAN N

ART UNIT	PAPER NUMBER
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3751

DATE MAILED: 04/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/842,371

Applicant(s)

BREIDENBACH ET AL.

Examiner

Tuan N. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) 32-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 and 40-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 4/3/06 have been fully considered but they are not persuasive as indicated in the rejections below.

### ***Claim Objections***

2. Claims 42-50 are objected to because of the following informalities: there is inconsistent "side wall" and "sidewall" in line 9 of claim 42. Appropriate correction is required.
3. Claim 50 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The amended independent claim 42 has already claimed the diameter of the receptacles is the same since they are the same with the diameter of the sleeve.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3, 4, 6, 7, 42 and 48-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Sakwa.

Sakwa discloses a dual ended container (see Fig. 4) comprising a sleeve (12) that has a first end (about 26) and a second end (about 28), each of the ends being adapted to receive a receptacle (about 16, about 50) for containing a product and wherein the product in the first receptacle is different from the product in the second receptacle and at least one of the receptacles has a rollerball applicator (14) for dispensing product from that receptacle, the receptacle with the rollerball applicator having a first end and a second end, the first end having the rollerball applicator (14) and being removably connected to the sleeve (12) as shown in Fig. 3; wherein the sleeve has a diameter and the receptacles have a diameter (see Figs. 3 and 4 where 72 is pointing) and wherein the diameter of the sleeves and the receptacles are generally the same. The receptacles have a sidewall (the side wall of 72 that abutting side wall of where 76 is pointing), wherein the sidewall of the first receptacle is parallel to the sidewall of the second receptacle (see Fig. 4). The sleeve has a first section and a second section which are connected by a sidewall (22), the first section and the second section being opened at each of said ends and is capable of receiving an opened end of a receptacle which contains a product. The sleeve and the receptacles have a cross section of the same shape, wherein the center axis of each end section is the same and wherein the center axis of the sleeve and each of the receptacles are the same.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-31 and 40-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roehrich in view of US Patent 5,586,694 (hereinafter Breidenbach), Costa, or Pieper et al. (hereinafter Pieper), or any combination thereof.

Roehrich discloses a dual ended container (see Fig. 1) comprising a sleeve (middle piece between the top and bottom piece) that has first and second ends, each of the ends being adapted to receive a receptacle (the top and bottom piece) for containing a product (such as perfume or the like) and wherein the product in the first receptacle could be different from the product in the second receptacle depend on the user wishes. The sleeve could obviously have a first section and a second section, which are connected by a sidewall (if not already) such that taught by Costa partition wall (1a). At least or only one of the receptacles can have a rollerball applicator (if not already) for dispensing product from that receptacle similar to the rollerball applicator of Breidenbach (see Fig. 5 of Breidenbach). The other claimed features such as the sidewall of the first receptacle is parallel to the sidewall of the second receptacle, the center axis, and the cross section shape are clearly shown and anticipated by Roehrich. Although the Roehrich receptacles are tapered; however, same diameter receptacles and sleeve are shown by Costa. Therefore, modifying the shape of the receptacles to have the same diameter as the sleeve would involve merely design choice.

Furthermore, the intended use with different product and all other functional phrases have been carefully considered but are deemed not to describe any structure patentably distinguishable over the device that disclosed by Roehrich which is certainly capable of

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being used in the claimed manner such as with a receptacle with a mascara brush as for example discloses by Costa or a doe foot applicator as for example discloses by Pieper.

6. The affidavit under 37 CFR 1.132 filed 4/3/06 is insufficient to overcome the rejection of claims 1-31 and 40-50 based upon the evidence is not commensurate with the scope of the claims as set forth in the last Office action because: in order to be commensurate in scope with the claims, the commercial success must be due to claimed features, and not due to unclaimed features; other equivalent language does not establish a nexus between the claimed invention and the commercial success because there is no evidence that the product which has been sold corresponds to the claimed invention, or that whatever commercial success may have occurred is attributable to the product or process defined by the claims; there is no evidence showing the commercial success alleged is directly derived from the invention claimed; the applicant must show that the claimed features were responsible for the commercial success of an article; and evidence of commercial success must be clearly attributable to the design to be of probative value, and not to brand name recognition. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.


### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan N. Nguyen whose telephone number is 571-272-4892. The examiner can normally be reached on Monday-Friday (10:00-6:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine R. Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Tuan Nguyen  
Primary Examiner  
Art Unit 3751  
4/20/06

TN